

AMENDMENTS TO THE DRAWINGS:

Applicant has amended FIG. 19 to include surface contours to comply with the examiner's request, and submits Replacement Sheet 3/3 containing this drawing amendment for the examiner's consideration. There are no other changes to the drawings.

REMARKS

No claims have been amended in this paper. Claims 4, 5, 8, 9 and 18-30 have been withdrawn. Claims 1-31 are pending. Applicant kindly requests that this amendment be entered by the examiner.

Amendments To The Drawings

Applicant respectfully submits that the drawings fully comply with M.P.E.P. 608.02, and 37 C.F.R. § 1.81. As to claim 1 providing “an uninterrupted polymer coating with a generally constant outside diameter adhering to and contiguous with the at least one of randomized and non-randomized tactile surface contours for at least a portion of the elongated wire core,” FIG. 19 has a generally constant OD with a non-uniform thickness not following the tapered profile; and claim 1 further providing “including at least a portion of the tapered distal end and having a surface contour that follows the at least one of randomized and non-randomized tactile surface contours in the elongated wire core,” FIGS. 5 or 9, for example, show a coating with a surface contour that follows one of the randomized or non-randomized tactile surface contours.

However, to expedite prosecution and to comply with the examiner’s request, applicant has amended FIG. 19 with surface contours and submitted this drawing amendment in Replacement Sheet 3/3 attached to this paper. No new matter is added; the drawing amendment is supported by the drawings as explained above.

Rejections under 35 U.S.C. § 102

Claims 1, 3, 6, 10, 11, 13, and 15 were rejected under 35 U.S.C. § 102(e) over van Sloun et al. (US 2004/0010189 A1). This rejection is respectfully traversed.

According to the examiner, van Sloun in FIG. 1 shows an uninterrupted coating 7 with a generally constant outside diameter adhering to and contiguous with the at least one of randomized and non-randomized tactile surface contours. However, FIG. 1 of van Sloun actually shows the coating 7 follow the surface contours of the *coil* 6, while claim 1 provides that the “uninterrupted polymer coating with a generally constant outside diameter *adhering to and contiguous with* the at least one of randomized and non-randomized tactile surface contours for at least a portion of the elongated wire *core* ...” (emphasis added). Thus, because the coating 7 in van Sloun does not adhere to and is not contiguous with the surface contours of the core, this reference does not anticipate claim 1. Applicant respectfully contends that the rejected claims are patentable over this reference.

Rejections under 35 U.S.C. § 103

Claims 2 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over van Sloun et al.(US 2004/0010189 A1) as applied to claim 1 in the Office Action, and further in view of McMahon (U.S. Patent 6,296,616). This rejection is respectfully traversed.

For the same reason as above with regard to claim 1, dependent claims 2 and 7 are patentable over van Sloun. McMahon adds nothing to the teachings of van Sloun with respect to claim 1 defining an “uninterrupted polymer coating with a generally constant outside diameter *adhering to and contiguous with* the at least one of randomized and non-randomized tactile surface contours for at least a portion of the elongated wire *core*.” Rather, the coating on van Sloun is not on the surface of the guidewire but on the surface of the coil. Therefore, because of this missing element, the rejected claims are not obvious in view of van Sloun and McMahon taken individually or in combination.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over van Sloun et al.(US 2004/0010189 A1) as applied to claim 1 in the Office Action, and further in view of Murayama et al. (US 2004/0039309 A1). This rejection is respectfully traversed.

Claim 14 depends on claim 1. As demonstrated above, van Sloun does not disclose or suggest an “uninterrupted polymer coating with a generally constant outside diameter adhering to and contiguous with the at least one of randomized and non-randomized tactile surface contours for at least a portion of the elongated wire core” as recited in claim 1. Murayama according to the examiner teaches use of nitinol in combination with stainless steel in a guidewire. Therefore, because of this missing element, the rejected claims are not obvious in view of van Sloun and Murayama taken individually or in combination.

Claims 1-3, 6, 7, 10, 11 and 14-17 were rejected under 35 U.S.C. § 103(a) over Stoltze et al. (U.S. Patent 6,033,720) in view of McMahon (U.S. Patent 6,296,616), Tezuka (U.S. 6,251,085 B1), and Sepetka (U.S. Patent 5,228,453). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stoltze et al. (U.S. Patent 6,033,720), McMahon (U.S. Patent 6,296,616), Tezuka (U.S. 6,251,085 B1), and Sepetka (U.S. Patent 5,228,453) as applied to claim 1 in the Office Action, and further in view of Slaikeu et al. (U.S. Patent 5,443,907). These rejections are respectfully traversed.

The examiner is attempting to combine the cited references and alleges, on page 7 of the Office action, that the motivation to combine these references is “to reduce surface contact and resistance to the movement of the guide wire ...” and for “ease of movement.”

However, Stoltze uses a hydrophilic coating 19 to reduce friction between the guidewire assembly and the surrounding vascular structure. (Stoltze, col. 6, lines 49-53.)

On the other hand, McMahon reduces resistance to movement through reducing the surface area of the coating in contact between the guidewire and the body lumen. (McMahon, col. 3, lines 1-4.) The examiner's stated motivation to combine these two references is to improve ease of movement, but this problem was already solved by Stoltze with a hydrophilic coating and already solved by McMahon by reducing surface contact. Hence, the examiner's stated motivation to combine is not, in fact, present for the two references because each had already solved the problem. The cited references' disclosures further give no reason to combine or modify their teachings.

Applicant contends that there is no motivation or suggestion in Stoltze to combine its teachings with McMahon, or vice versa. Rather, applicant respectfully notes that the examiner is improperly using hindsight from applicant's invention as the motivation to combine these references. Without proper motivation to combine, applicant believes that the obviousness claim rejections cannot stand.

Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stoltze et al. (U.S. Patent 6,033,720) in view of McMahon (U.S. Patent 6,296,616), Tezuka (U.S. 6,251,085 B1), Sepetka (U.S. Patent 5,228,453) and Slaideu et al. (U.S. Patent 5,443,907). This rejection is respectfully traversed.

Applicant demonstrated above that Stoltze and McMahon were improperly combined based on hindsight. Applicant maintains here that it is improper to combine Stoltze and McMahon because there is no motivation to combine these references. Therefore, if Stoltze and McMahon cannot be combined, the obviousness rejection for claim 31 should be withdrawn.

Applicant respectfully disagrees with the other grounds for rejection proffered by the examiner not specifically addressed above.

CONCLUSION

In view of the foregoing, applicant respectfully submits that all claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited. Applicant invites the examiner to telephone the undersigned if there are any remaining questions. It is believed that no additional fee is required for the filing of this response. However, if a fee is in fact due, the Commissioner is authorized to charge any fees or costs to our Deposit Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LLP

By: /Paul Y. Feng/
Paul Y. Feng
Registration No. 35,510

PYF:njw

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201

384314.1